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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* KENNETH A. PARULSKI
9

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11 Appeal 2008-2982
12 Application 09/534,471
13 Technology Center 3600
14

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16 Decided: December 11, 2008
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19 *Before* ANTON W. FETTING, DAVID B. WALKER, and JOHN C.
20 KERINS, *Administrative Patent Judges*.

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22 FETTING, *Administrative Patent Judge*.
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25 DECISION ON APPEAL

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27 STATEMENT OF THE CASE

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29 Kenneth A. Parulski (Appellant) seeks review under 35 U.S.C. § 134
30 of a final rejection of claims 1-6 and 9-19, the only claims pending in the
31 application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM-IN-PART.

The Appellant invented a configured camera system and a method that uses the Internet to lease such configured camera systems (Specification 1:13-15).

An understanding of the invention can be derived from a reading of exemplary claims 1 and 17, which are reproduced below [bracketed matter and some paragraphing added].

1. A method for a customer leasing a configured camera system including a camera and services for using such configured camera system and paying for the lease of such configured camera system, comprising the steps of:

- (a) providing an electronic database of information describing a plurality of differently configured camera systems which have different features and services that can be selected by the customer via a digital communications network;
- (b) displaying at the customer's location remote from the electronic database various components of the camera system that can be combined into the configured camera system;
- (c) the customer selecting desired components and services to provide the configured camera system and completing a lease agreement and providing a payment identifier specifying an account to be debited to pay for the configured camera system; and
- (d) sending the camera to a designee of the customer and establishing a service user account that specify the selected services that the designee can use with respect to the images captured by said camera.

17. A camera for capturing images to be provided to a service provider, comprising:

- (a) means for capturing and storing images;

- (b) a firmware memory for storing a service identifier which identifies a service provider account, the service provider account specifying services to be provided by the service provider; and
(c) means for providing the captured images and the service identifier to the service provider.

This appeal arises from the Examiner's Final Rejection, mailed January 13, 2003. The Appellant filed an Appeal Brief in support of the appeal on April 13, 2007. An Examiner's Answer to the Appeal Brief was mailed on September 17, 2007. A Reply Brief was filed on October 25, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Kitagawa US 5,819,126 Oct. 6, 1998
Admitted Prior Art (Specification).

REJECTIONS

Claims 17-19 are rejected under 35 U.S.C. § 102(b) as anticipated by Kitagawa.

Claims 1-6 and 9-16 are rejected under 35 U.S.C. § 103(a) as unpatentable over the Admitted Prior Art in view of Kitagawa.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 17-19 under 35 U.S.C. § 102(b) as anticipated by Kitagawa.

- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-6 and 9-16 under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art in view of Kitagawa.

The pertinent issues turn on whether Kitigawa identically discloses limitations [b] and [c] of claim 17 and whether the Admitted Prior Art and Kitigawa disclose limitations [a-d] of claim 1.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of the term “lease.”
02. The ordinary and customary meaning of “lease” is “to grant use or occupation of under the terms of a contract.”¹

Facts Related to Appellant’s Disclosure (Admitted Prior Art)

03. Dell’s website enables a user to configure or customize a computer by selecting various options (Specification 2:1-6).
04. Dell’s website allows a user to order selected equipment, including customized or configured equipment, over the Internet (Specification 2:9-11).
05. A “learn more” link for each option for an advertised product on Dell’s website provides a detailed description of the options a user can select (Specification 2:4-6).

06. Bestcameras.com describes ordering single use cameras
(Specification 3:1-6).

Kitagawa

07. Kitagawa teaches a method for recording photographic data
while using a photo capturing device (Kitagawa col. 1 ll. 6-7).

08. Kitagawa teaches capturing and recording photographic images
into memory (Kitagawa col. 9, ll. 9-10 and figure 5).

09. The IC memory includes fundamental data including unit ID,
date of manufacture, flash data, print format data, and clock pulse
number data (Kitagawa col. 9, ll. 30-33).

10. The camera with film is forwarded to a photo-lab, the data in
the IC memory is read and transferred to the magnetic recording
surface of the film, photographic images printed at the photo-lab
and returned back to the customer/photographer at a photo-shop
(Kitagawa col. 7, ll. 66-67, col. 8 ll. 1-30, col. 12, ll. 14-17, and
col. 12, ll. 26-28).

Facts Related To The Level Of Skill In The Art

11. Neither the Examiner nor the Appellant has addressed the level
of ordinary skill in the pertinent arts of data recording in
photography. We will therefore consider the cited prior art as
representative of the level of ordinary skill in the art. *See Okajima*
v. Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
absence of specific findings on the level of skill in the art does not
give rise to reversible error ‘where the prior art itself reflects an
appropriate level and a need for testimony is not shown’”)

¹ *American Heritage Dictionary of the English Language* (4th ed. 2000).

(quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

12. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses

to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Claim Preamble

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed.Cir. 1995). If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is "necessary to give life, meaning, and vitality" to the claim, then the claim preamble should be construed as if in the balance of the claim. *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951). "If, however, the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed

anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: "[1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR Int'l v. Teleflex Inc.*, 127 S. Ct. at 1734. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, at 1739.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field

1 or a different one. If a person of ordinary skill can implement a predictable
2 variation, § 103 likely bars its patentability.” *Id.* at 1740.

3 “For the same reason, if a technique has been used to improve one
4 device, and a person of ordinary skill in the art would recognize that it would
5 improve similar devices in the same way, using the technique is obvious
6 unless its actual application is beyond his or her skill.” *Id.*

7 “Under the correct analysis, any need or problem known in the field
8 of endeavor at the time of invention and addressed by the patent can provide
9 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

10
11 ANALYSIS

12 *Claims 17-19 rejected under 35 U.S.C. §102(b) as anticipated by Kitagawa*

13 The Appellant argues these claims as a group.

14 Accordingly, we select claim 17 as representative of the group.
15 37 C.F.R. § 41.37(c)(1)(vii) (2007).

16 The Examiner found that Kitagawa describes all of the limitations of
17 claim 17 and thus Kitagawa anticipates the present invention (Answer 4-5).

18 The Appellant contends that:

- 19 1. Kitagawa fails to teach firmware for storing a service identifier
20 (Br. 6, first paragraph).
- 21 2. Kitagawa fails to teach that the service identifier identifies a
22 service provider *account* (Br. 6, first paragraph and second
23 paragraph).
- 24 3. Kitagawa fails to teach a means for providing the captured
25 images and the service identification to the service provider (Br.
26 6, first paragraph).

1 We disagree with the Appellant. First, it is uncontested that limitation
2 (a) in claim 17 is described by Kitagawa (FF 08).

3 The Appellant broadly contends that Kitagawa fails to describe a
4 firmware for storing a service identifier and a means for providing the
5 captured images and the service identification to the service provider (Br. 6,
6 first paragraph). We are not persuaded by this argument. Kitagawa
7 describes an IC memory, which is a firmware memory that actually stores a
8 unit identifier, and is therefore capable of storing information including a
9 service identifier (FF 08 and 09). Kitagawa further describes forwarding the
10 camera with film to a photo-lab and the film contains identification
11 information that has been transferred from the IC memory (FF 10).

12 The Appellant further argues that Kitagawa fails to describe a service
13 provider account (Br. 6, first and second paragraph). The Examiner
14 responds by contending that the purpose for which the memory will be used
15 (i.e., storing a service identifier which identifies a service provider account)
16 is merely an intended use (Answer, page 7, last full paragraph) and does not
17 result in a structural difference between the present invention and Kitagawa.
18 We agree with the Examiner. Claim 17 recites an apparatus and thus the
19 intended use must result in a structural difference between the present
20 invention and the camera system described by Kitagawa. The only
21 structural limitation regarding the firmware memory in claim 17 is that it be
22 capable of storing an identifier, not the use to which the memory contents
23 might be put.

24 "[E]xpressions relating the apparatus to contents thereof during an
25 intended operation are of no significance in determining patentability of the
26 apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Furthermore, "inclusion of the material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Otto*, 312 F.2d 937, 940 (CCPA 1963).

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 17-19 under 35 U.S.C. § 102(b) as unpatentable over Kitagawa.

*Claims 1-6 and 9-16 rejected under 35 U.S.C. §103(a) as unpatentable over
Admitted Prior Art in view of Kitagawa*

The Appellant argues these claims in four groups:

Group II:	Claim 1
Group III:	Claims 2-3
Group IV:	Claims 4-6 and 16
Group V:	Claims 9-15

Group II

The Examiner found that the Admitted Prior Art, as exemplified by the Dell.com and Bestcameras.com web site discussions found in the Specification, taught all of the limitations of claim 1 except that the items being sold were not customized camera systems (Answer 5-6). The Examiner found that Kitagawa cured this deficiency, pointing out that Kitagawa taught offering customized camera systems, and further found that it would have been obvious to combine Kitagawa with the Admitted Prior Art in order for a company selling one-time use cameras to increase its profits by reaching a wider market while satisfying a range of specific market niches (Answer 6).

The Appellant contends that:

- 1 1. The Admitted Prior Art fails to describe uploading personal
2 data or digital images that are used to personalize the computer
3 or the merchandise and thus the information provided is not for
4 establishing what services are provided (Br. 7, first paragraph).
- 5 2. The Admitted Prior Art fails to describe a camera designed to
6 capture images and the captured images are used for producing
7 image products such as photographic prints (Br. 7, second
8 paragraph).
- 9 3. The Admitted Prior Art and Kitigawa fail to describe leasing a
10 camera (Br. 7 third paragraph and Br. 8, second paragraph).
- 11 4. The Admitted Prior Art and Kitigawa fail to describe providing
12 a payment identifier that specifies an account to be debited for
13 the payment of the configured camera system (Br. 8, first
14 paragraph).
- 15 5. The Admitted Prior Art and Kitigawa fail to describe sending of
16 the camera to a designee of the customer and establishing a
17 service user account as specified as selected services that the
18 designee can use with respect to the images captured by the
19 camera (Br. 8, first paragraph).
- 20 6. There is no motivation to combine the Admitted Prior Art and
21 Kitigawa (Br. 9, first paragraph).

22 We will not sustain this rejection, for the reasons set forth *infra*. We
23 will consider the Appellant's arguments that are pertinent to the analysis of
24 claim 2 in the analysis of that claim following below.

25 With respect to "establishing a service user account that specify [sic.]
26 the selected services that the designee can use with respect to the images

captured by said camera,” we agree with the Appellant that the prior art is deficient. The Examiner has failed to make a finding that this feature is described in the Admitted Prior Art. We do not see any description in the Admitted Prior Art or Kitagawa of this claim feature. We therefore find the Examiner has failed to make a prima facie case of obviousness as to claim 1.

The Appellant has sustained his burden of showing that the Examiner erred in rejecting claim 1. We reverse the Examiner’s rejection of claim 1.

Group III

The Appellant argues claims 2 and 3 as a group. Accordingly, we select claim 2 as representative of the group. The Examiner rejected claim 2 for the reasons set forth in the rejection of claim 1. The Appellant contends that claim 2 is distinguished from claim 1 because it additionally recites the feature of selecting programs which depict the functionality of the desired services. The Appellant contends that the neither the Admitted Prior Art nor Kitagawa describe this feature (Br. 10, first incomplete paragraph).

We disagree with the Appellant. First we take up the arguments from claim 1 that pertain to claim 2.

The Appellant contends that the Admitted Prior Art and Kitagawa fail to describe leasing a camera (Br. 7, third paragraph and Br. 8, second paragraph). We disagree with the Appellant. Claim 2’s recitation of a lease occurs only in its preamble and this recitation is unnecessary to define the invention. The preamble merely calls for a method “for configuring a camera and paying for the lease.” None of the steps refer to the lease. To the contrary, step (c) calls for debiting an account rather than executing a lease.

1 If . . . the body of the claim fully and intrinsically sets forth the
2 complete invention, including all of its limitations, and the
3 preamble offers no distinct definition of any of the claimed
4 invention's limitations, but rather merely states, for example,
5 the purpose or intended use of the invention, then the preamble
6 is of no significance to claim construction because it cannot be
7 said to constitute or explain a claim limitation.

8 *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed.
9 Cir. 1999).

10 The Appellant further argues that the Admitted Prior Art and Kitigawa
11 fail to describe sending of the camera to a designee of the customer (Br. 8,
12 first paragraph). We disagree with the Appellant. The Admitted Prior Art
13 describes ordering a customized product over the Internet (FF 04) which
14 implicitly describes shipment of the product to a specific person or place.

15 The Appellant further contends that there is no motivation to combine
16 the Admitted Prior Art and Kitagawa (Br. 9, first paragraph). The Admitted
17 Prior Art describes customizing a product (FF 03) and Kitagawa describes a
18 camera system (FF 07). The Examiner concluded that one of ordinary skill
19 in the art would be motivated to combine these references in order to
20 increase profits by selling customized cameras via the Internet (Answer page
21 6, second paragraph). The Appellant responds that the combination of the
22 Admitted Prior Art and Kitagawa would only result in the sales of already
23 customized cameras (Br. 9, first paragraph). We do not find this argument
24 persuasive because the Admitted Prior Art describes the customizing of a
25 product (as discussed above) and thus the combination of the Admitted Prior
26 Art and Kitagawa would result in enabling a user to customize a camera
27 system according to the customer's desires as well.

Next we take up the arguments made specifically in support of claim 2. The Admitted Prior Art describes a “learn more” link depicted next to selectable options that describes the details, which would include the functionality of the options (FF 05). This therefore describes depicting the functionality of desired features, and thus discloses this limitation of claim 2.

The Appellant has not sustained his burden of showing that the Examiner erred in rejecting claim 2. We affirm the Examiner’s rejections of claims 2 and 3.

Group IV

The Appellant argues claims 4-6 and 16² as a group. Accordingly, we select claim 4 as representative of the group. The Examiner rejected claim 4 for the reasons set forth in the rejection of claims 1 and 2. The Appellant contends that claim 4 is distinguished from claims 1 and 2 because it recites the additional feature of capturing the image using the configured camera and forwarding such image for storage to a designated location. The Appellant contends that neither the Admitted Prior Art nor Kitagawa describe this feature (Br. 10, first complete paragraph).

² The Appellant contends that claims 4-6 and 16 depend on independent claims 2 or 9 (Br. 10, second paragraph); however, claims 4-6 and 16 depend on independent claim 2. None of these claims depend from independent claim 9.

CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 2-6 and 16-19, but has sustained his burden of showing that the Examiner erred in rejecting claims 1 and 9-15.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 17-19 under 35 U.S.C. §102(b) as anticipated by Kitagawa is affirmed.
- The rejection of claims 1 and 9-15 under 35 U.S.C. §103(a) as unpatentable over Admitted Prior Art in view of Kitagawa is reversed.
- The rejection of claims 2-6 and 16 under 35 U.S.C. §103(a) as unpatentable over Admitted Prior Art in view of Kitagawa is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

hh

EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHSTER, NY 14650-2201